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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,269	03/04/2004	Peter Gansen	03100197AA	4232

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,269

Applicant(s)

GANSEN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-17 and 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-17, 19-26, 28, 30-32, and 34-38 is/are rejected.
- 7) ☒ Claim(s) 27, 29 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment of 8/24/06 has been entered. Claims 14-17 and 19-38 are pending.

The examiner looked again but could not find the foreign priority document. The office has switched to a computerized file system. The examiner has no access to the papers filed. He has messaged the appropriate personnel to locate the lost paper but it is possibly more expedient to send another copy of said document. If the applicant notices that the document is available in the computer file available to them please let the examiner know.

2. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 does not further limit a previous claim.

3. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification only references polyethers having the amount of primary OH groups of the instant claim 31. The instant claim encompasses any type of compound having this proportion of primary OH groups. The scope of these compounds other than the polyethers disclosed by the originally filed specification is new matter because the specification as originally filed does not show that the applicant had possession of the invention in which compounds, other than the disclosed polyethers, having the claimed amount of primary OH groups.

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4. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 31 recites “more than 60% of primary OH groups”. It is unclear if the percentage is based on weight of the compound or the number of functional groups such as those well known compounds which have mixtures of functional groups such as SH and OH groups or NH and OH groups.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17 and 36-38 are rejected under 35 U.S.C. 102(b and e) as being anticipated by EP 1095993 A2, which is prior art under section b, as translated by US Pat. Application Pub. No US 2005/0263243 Schumann et al. which is prior art under section e.

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Schumann discloses the instantly claimed polyurethane compositions and foils at the abstract; sections [0058]. [0094] through [0107] which encompasses the instantly claimed oxide particles, polyisocyanates, polyols, catalyst, [0113], [0115][0119], [0136], [0142]-[0221], particularly the examples of sections [0144], [0152], [0159] and the remaining examples of the above cited sections, the claims, and the remainder of the document. No amine initiator is used. Removal of the film, i.e. foil, of the reference from its release layer constitutes the “demolding” of the instant claims. Claims 17 and 36 recite “comprising” regarding the foil and therefore encompass the adhesive layer of the reference. The components of the examples are those of the instant claims which is clear on its face. They are clearly stored separately until use. There is no probative showing that any additional materials of the reference’s exemplified compositions cited above materially affect the basic and novel characteristics of the composition. Therefore the additional materials of the reference are not excluded by “consisting essentially of” of the instant claim 38. The release layer of the tape of the reference is clearly removed to reveal the adhesive layer on the polyurethane backing as would be understood by the term “release paper” in the context of the reference. This removal of the release layer constitutes removal of a “smooth surface” or “demolding”. Its ability to be removed from a release layer is clear evidence that the polyurethane films, i.e. foils, of the reference have the ability to be demolded, i.e. they are clearly demoldable. The reference compositions fall squarely within the scope of the instant claims. The applicant therefore fails to show how the instantly claimed compositions “do not overlap Schumann.” Claims 37 and 38 do not require the compositions to be sprayable. The fact that the compositions of the reference are liquid is prima facie evidence that they have the ability to be sprayed by some means if in fact they are not actually applied by spraying and even

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if this ability to be sprayed requires dilution with solvent. That they form films is clearly taught by the reference. See the entire document, particularly the examples, more particularly the example at section [0165] for the instantly claimed film thickness. The above is fully responsive to the applicant's arguments on the face of the above rejection. This rejection is therefore maintained.

8. Claims 14-17, 19-26, 28, 30-32, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of EP 1095993 A2 and US Pat. Application Pub. No US 2005/0263243 Schumann et al..

Schumann discloses the instantly claimed polyurethane compositions and foils at the abstract; sections [0058], [0094] through [0107] which encompasses the instantly claimed oxide particles, polyisocyanates, polyols, catalyst, [0113], [0115][0119], [0136], [0142]-[0221], particularly the examples of sections [0144], [0152], [0159] and the remaining examples of the above cited sections, the claims, and the remainder of the document. No amine initiator is used. Removal of the film, i.e. foil, of the reference from its release layer constitutes the "demolding" of the instant claims. Claims 17 and 36 recite "comprising" regarding the foil and therefore encompass the adhesive layer of the reference. The components of the examples are those of the instant claims which is clear on its face. They are clearly stored separately until use. There is no probative showing that any additional materials of the reference's exemplified compositions cited above materially affect the basic and novel characteristics of the composition. Therefore the additional materials of the reference are not excluded by "consisting essentially of" of the instant claim 38. The release layer of the tape of the reference is clearly removed to reveal the adhesive layer on the polyurethane backing as would be understood by the term "release paper"

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in the context of the reference. This removal of the release layer constitutes removal of a “smooth surface” or “demolding”. Its ability to be removed from a release layer is clear evidence that the polyurethane films, i.e. foils, of the reference have the ability to be demolded, i.e. they are clearly demoldable. The reference compositions fall squarely within the scope of the instant claims. The applicant therefore fails to show how the instantly claimed compositions “do not overlap Schumann.” Claims 37 and 38 do not require the compositions to be sprayable. The fact that the compositions of the reference are liquid is prima facie evidence that they have the ability to be sprayed by some means if in fact they are not actually applied by spraying and even if this ability to be sprayed requires dilution with solvent. That they form films is clearly taught by the reference. See the entire document, particularly the examples, more particularly the example at section [0165] for the instantly claimed film thickness.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use spraying of the instant claims 14-16 to apply the above discussed polyurethane because the reference states that application may be done “in a customary coating process” at section [0032] and spraying solutions of coating is one of the most well known and used means to coat from a solution and its benefits such as uniform coating would have been expected in the coating of the references which use the instantly claimed temperatures and thicknesses (section [0170]).

Example at [0171] applies the urethane at the temperature of the instant claim 16. The isocyanates of the examples cited above have the NCO content of the instant claim 22 and the functionality thereof. Omyacarb 4BG of the examples falls within the scope of the instant claim 24. The examples of the reference use the amounts of the instant claims 25 and 26. Sections

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[0098] and [0107] read on the instant claim 28. The exemplified polyols contain 100% primary OH groups which falls within the scope of the instant claim 31 and the examples use the polyisocyanates of the instant claim 30. Using the fillers and siccatives of the reference meets the instant claim 32.

This rejection is therefore maintained.

9. Claims 27, 29, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is not proper motivation to modify the products and compositions of the prior art according to the instant claims.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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